



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,038	08/31/2001	Ann Mond Johnson		3056

34060 7590 01/18/2006
MICHAEL N. HAYNES
1341 HUNTERSFIELD CLOSE
KESWICK, VA 22947

EXAMINER

COBANOGU, DILEK B

ART UNIT PAPER NUMBER

3626

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/945,038

Applicant(s)

JOHNSON ET AL.

Examiner

Dilek B. Cobanoglu

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-12 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 to 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. The basis of this rejection is set forth in a two-prong test of:

- (1) Whether the invention is within the technological arts, or
- (2) The invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the claims only recite an abstract idea.

Exemplary claim 1 recites a method comprising: providing healthcare information and treatment options; identifying treatment

Art Unit: 3626

options. However, there is no requirement within the recited means to positively and definitely require the technological arts. For example, "providing healthcare information relating a condition" means may be nothing more than a booklet or any document contain information about that condition, provided by a counselor or any employee from a hospital or doctor's office, to the patient or to an individual; "a database" could be nothing more than a file cabinet. Also, the "identifying treatment options for that condition" can be done by a conversation between the patient or customer and a counselor or any healthcare personnel. As such, it is respectfully submitted that the claimed system and method is not within the technological arts.

Similar analysis holds for method claim 2, 3, 4, 5, 6 and 7.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 to 7, 9 and 12 are rejected under 35 U.S.C. 102(e) as being unpatentable by Papageorge (U.S. Patent No. 6,584,445).

Art Unit: 3626

A. As per claim 1, Papageorge discloses a method for providing healthcare information and treatment options for a previously diagnosed condition (Papageorge; abstract), said method comprising the steps of:

- i. providing information relating to said condition (Papageorge; col.8, lines 13-14) from at least one database (Papageorge; abstract); and
- ii. identifying treatment options for said condition (Papageorge; col.8, line 17).

B. As per claim 2, Papageorge discloses the method of claim 1, further comprising the step of correlating the identified treatment options with demographic data (Papageorge; col.8, lines 25-26).

C. As per claim 3, Papageorge discloses the method of claim 1, further comprising the step of correlating the identified treatment options with selected and ranked criteria (Papageorge; col.8, lines 18-21).

D. As per claim 4, Papageorge discloses the method of claim 1, further comprising the step of updating said at least one database (Papageorge; col.7, lines 17-19).

E. As per claim 5, Papageorge discloses a method for healthcare decisionmaking (Papageorge; abstract) comprising the steps of:

- i. selecting a previously diagnosed condition (Papageorge; col.5, lines 29-31);
- ii. entering demographic data (Papageorge; col.8, lines 25-27);

Art Unit: 3626

- iii. providing information relating to said condition (Papageorge; col.8, lines 13-14) from at least one database (Papageorge; abstract);
- iv. selecting and ranking criteria related to said condition (Papageorge; col.8, lines 15-17);
- v. providing treatment options for said condition (Papageorge; col.8, line 17).

F. As per claim 6, Papageorge discloses the method of claim 5, further comprising the step of comparing said treatment options (Papageorge; col.8, lines 20-21).

G. As per claim 7, Papageorge discloses the method of claim 5, wherein said step of providing treatment options (Papageorge; col.8, line 17) comprises the steps of:

- i. correlating the identified treatment options with at least one of the demographic data and the selected and ranked criteria (Papageorge; col.8, lines 18-21 and 25-26); and
- ii. identifying the best matched treatment options related to said at least one of the identified demographic data and the selected and ranked criteria (Papageorge; col.8, lines 18-21).

H. As per claim 9, Papageorge discloses the system of claim 8 (Papageorge; abstract), wherein said system further comprises a means for querying (Papageorge; col.6, lines 57-65) said information database (Papageorge; col.7, lines 8-9).

Art Unit: 3626

Examiner considers the interactive multimedia which has written and voice instructions and questionnaire forms as kinds of querying.

I. As per claim 12, Papageorge discloses the system of claim 8 (Papageorge; abstract), wherein consumer healthcare preference information is obtained from external agencies (Papageorge; col.7, lines 60-65), public opinion surveys (Papageorge; col.8, lines 23-25) and previous users of the system (Papageorge; col.7, line 65 to col. 8, line 2).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papageorge (U.S. Patent No. 6,584,445) in view of Iliff (U.S. Patent No. 5,660,176).

A. As per claim 8, Papageorge discloses a system for providing healthcare information and treatment options for a previously diagnosed condition (Papageorge; abstract), said system comprising:

- i. a conditions database for storing past consumer criteria related to healthcare conditions (Papageorge; col.7, lines 9-10);

- ii. a means for querying (Papageorge; col.6, lines 57-65) said conditions database, said means for querying correlates individual demographic characteristics with preferences contained in said conditions database (Papageorge; col.8, lines 25-26);
- iii. a means for adding consumer preference criteria and demographic data to said conditions database (Papageorge; col.7, lines 4-10);
- iv. a facilities database (Papageorge; col.7, lines 14-15) for storing healthcare provider information
- v. an information database for storing consumer healthcare preference information (Papageorge; col.7, lines 4-9).

Papageorge fails to expressly teach healthcare provider information, per se, since it appears that Papageorge is more directed to provide a module for physicians' opinions on the patient's condition. However, this feature is well known in the art, as evidenced by Iliff.

In particular, Iliff discloses a computerized medical diagnostic and treatment advice system, wherein the system provides a list of participating specialists (Iliff; col.42, lines 10-17).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined a module for physicians disclosed by Papageorge within to provide a

list of participating specialists taught by Iliff with the motivation of the system finds that the patient should see a physician and instructions given to the patient with the recommendation to make an appointment (Iliff; col.42, lines 14-17).

B. As per claim 10, Papageorge discloses the system of claim 8, wherein said demographic characteristics includes age, sex, education (Papageorge; col.4, lines 28-34) and region or geographic area (Papageorge; col.7, lines 27-29).

Papageorge fails to expressly teach to store the age and sex of the patient as an input, per se, since it appears that Papageorge is more directed to obtain patient's work, family, lifestyle, treatment preferences and so on. However, this feature is well known in the art, as evidenced by Iliff.

In particular, Iliff discloses a computerized medical diagnostic and treatment advice system, wherein the system holds patient specific data such as age and sex (Iliff; col.18, lines 7-10).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined patient's work, family, lifestyle, treatment preferences disclosed by Papageorge within patient's specific data such as age and sex taught by Iliff with the motivation of the patient to confirm

that the age and sex information to move to a decision stage
(Iloff; col.30, lines 22-26).

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Papageorge (U.S. Patent No. 6,584,445) in view of Iliff (U.S. Patent No. 5,660,176) as applied to claim 8 above, and further in view of DeBruin-Ashton (U.S. Patent No. 6,014,629).

A. As per claim 11, Papageorge discloses the system of claim 8, wherein said health care provider information includes location, capabilities, procedures performed and conditions treated per annum.

Papageorge and Iliff fail to expressly teach the health care provider information includes location, capabilities, procedures performed and conditions treated per annum, per se, since it appears that Papageorge is more directed to physicians' opinions on the patient's condition (Papageorge; col.7, lines 10-14) and Iliff is more directed to a list of participating specialists (Iliff; col.42, lines 10-17).

However, this feature is well known in the art, as evidenced by DeBruin-Ashton.

In particular, DeBruin-Ashton discloses a personalized healthcare provider directory, wherein the data is extracted to identify physicians having offices in the zip code of a customer or location information, having specialties corresponding to a particular customer's needs or

Art Unit: 3626

capabilities (DeBruin-Ashton; col.3, lines 58-63) and other information which may be of interest of customer (DeBruin-Ashton; col. 6, lines 56-62)

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined a list of participating specialists disclosed by Iliff within a personalized healthcare provider directory taught by DeBruin-Ashton with the motivation of the customer is not presented with excessive number of physicians (DeBruin-Ashton; col. 6, lines 56-62).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied arts teach "Computer system and method for suggesting treatments for physical trauma" (4,839,822), "Health care management system for managing medical treatments and comparing user-proposed and recommended resources required for treatment" (5,583,758), "Method of modifying comparable health care services" (5,724,379), "Electronic medical records system" (5,924,074), "Health care management system for comparing user-proposed and recommended resources required for treatment" (5,953,704), "Computer implemented patient medication review system and process for the managed care, health care and/or pharmacy industry" (6,014,631), "System for screening of medical decision making incorporating a knowledge base" (6,049,794), "Automated treatment selection method"

Art Unit: 3626

(6,063,028), "Systems, methods and computer program products for guiding the selection of therapeutic treatment regimens" (6,081,786).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dilek B. cobanoglu
Art Unit 3626



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER